

REMARKS

This communication is submitted in response to the Office Action dated August 7, 2007.

Claims 1-22 are pending in the subject patent application, with claims 9, 14, 15, 16, 17, 18 and 19 being amended herewith. Claims 1-8, 10-13 and 20-22 have not been changed relative to their immediate prior version.

Independent claim 9 and dependent claim 16 have been amended to delete the term "interconnected" in describing the steps that comprise the stepped pattern of the helical cut. The term "interconnected" is believed to be redundant and superfluous in view of the fact that independent claim 9 and independent claim 14, from which claim 16 depends, already recite the helical cut as being "continuous". Claims 14, 15 and 17-19 have been amended to better clarify the limitations recited for the inner tube in terms of their relationship to other structure defined in the claims. Support for the amended claims is found throughout the specification as originally filed such that the amendments do not introduce any new matter.

Reconsideration of the subject patent application is respectfully requested in view of the foregoing amendments and the following remarks.

The rejection of claims 14 and 17-19 under 35 USC §112, second paragraph, the rejection of claims 1-22 on the ground of nonstatutory obviousness-type double patenting, the rejection of claims 1, 6, 7, 9-11 and 14-21 as being anticipated by Peters et al, the rejection of claims 2-5 as being unpatentable over Peters et al in view of Aznoian et al, the rejection of claims 8, 12, 13 and 22 as being unpatentable over Peters et al, and the rejection of claims 17-19 as being unpatentable over Peters et al in

view of applicant's disclosure are all respectfully traversed for the following reasons.

Initially, it should be noted that claims 14 and 17-19 were not rejected by the Examiner in the previous Office Action under 35 USC §112, second paragraph, but only now stand rejected on this basis. The Examiner's failure to earlier reject claims 14 and 17-19 under 35 USC §112, second paragraph, if such a rejection was warranted, is clearly not in keeping with the requirement embodied in 37 CFR §1.104(b) and in the Manual of Patent Examining Procedure §707.07(a) that a first Office Action on the merits be complete as to all matters, and the requirement set forth in the Manual of Patent Examining Procedure §707.07(g) that piecemeal examination be avoided. However, irregardless of the impropriety concerning the timing of the rejection under 35 USC §112, second paragraph, the rejection itself is submitted to be improper as explained below.

The threshold requirement of 35 USC §112, second paragraph, is that the claims define the patentable subject matter with a reasonable degree of particularity and distinctness, regardless of whether more suitable language or modes of expression are available or whether the claim language is not as precise as the Examiner might desire (MPEP §2173.02). The fact that claim language may not be precise does not automatically render the claim indefinite under 35 USC §112, second paragraph, since acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of applicant's specification (MPEP §2173.05(b)). The clear intent of 35 USC §112, second paragraph, is that claim language be analyzed in light of the content of the particular application disclosure and the interpretation that would be given to the language by one possessing the ordinary

level of skill in the pertinent art (MPEP §2173.02). Viewed in this light, the rejections of claims 14 and 17-19 under 35 USC §112, second paragraph, are believed to be clearly improper. However, claims 14 and 17-19 have been amended herewith in an attempt to provide additional clarity and precision and are believed to overcome the rejection based on 35 USC §112, second paragraph.

With respect to the rejection of claim 14 in particular under 35 USC §112, second paragraph, the Examiner asserts that the diametric size of the straight tissue cutting instrument is not defined and thus the limitation does not provide any structural limitations. Applicant respectfully disagrees. The diametric size of the straight tissue cutting instrument is defined in the preamble of independent claim 14 as a “standard” diametric size, which is explained in applicant’s specification and which would be understood by one of ordinary skill in the art. With respect to the rejection of claims 17-19 under 35 USC §112, second paragraph, the Examiner improperly asserts that the claims do not provide any size limitations because the inner diameter of each straight tissue cutting instrument is not recited. Notably, claims 17-19 have each been amended to depend from claim 15, which requires that the inner tube be the same as the inner tube forming the inner tubular member of the straight tissue cutting instrument of the same standard diametric size. As previously pointed out, independent claim 14, from which claim 15 depends, defines the standard diametric size of the straight tissue cutting instrument with clarity and particularity, especially when viewed in light of applicant’s disclosure. By inclusion, claims 17-19 define the standard diametric sizes of the straight tissue cutting instrument, which necessarily have corresponding inner tubular members, and the claims relate the inner diameters of the recited inner tubes to

the inner diameters of the inner tubes forming the inner tubular members of the respective standard straight tissue cutting instruments. Claims 14 and 17-19 recite positive limitations for the inner tubular member in terms of their relationship to other structure defined in the claims and in a manner consistent with 35 USC §112, second paragraph. Accordingly, the rejection of claims 14 and 17-19 under 35 USC §112, second paragraph, is believed to be addressed and overcome, and it is respectfully requested that the rejection be withdrawn.

The rejection of claims 1-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-10, 12-13, 15-19 and 21 of U.S. Patent No. 6,656,195 to Peters et al in view of U.S. Patent No. 5,908,381 to Aznoian et al is submitted to be improper. Contrary to the Examiner's assertion, the Peters et al patent and the instant application do not claim common subject matter. Each of claims 1, 6-10, 12, 13 and 15-19 of the Peters et al patent requires a helical cut to be formed in the inner tube in a pattern defining interlocking tenons and mortises between adjacent tube segments, and interlocking tenons and mortises form no part of the claimed invention. Rather, each of independent claims 1, 9 and 14 in the subject application require a continuous helical cut formed in a stepped pattern, which does not result in interlocking tenons and mortises as does the dovetail pattern disclosed by Peters et al. Applicant respectfully disagrees with the Examiner's assertion that the stepped pattern recited for the helical cut in the claims of the subject application is an obvious design choice. In particular, the combination of a stepped pattern for the helical cut and no more than a single layer of spiral wrap disposed over the helical cut gives rise to numerous advantages discussed in applicant's specification (paragraphs

0014 - 0025, 0066 and 0067), including the strength and torque transmitting capability that allows the inner tubular member to be formed using an inner tube that is the same as the inner tube of a straight tissue cutting instrument of the same standard diametric size as the angled tissue cutting instrument without sacrificing aspiration efficiency and without increased risk of clogging. Independent claim 21 of the Peters et al patent requires a segmented region of the inner tubular member to have a first pitch along a central portion thereof and a second pitch, greater than the first pitch, along distal and proximal portions thereof, and independent claims 1, 9 and 14 of the subject application do not require this feature. The present applicant and the Peters et al patent cannot reasonably be said to claim common subject matter.

No teachings are provided by the Aznoian et al patent which would be combinable with the Peters et al patent to render the claims of the subject application obvious. Aznoian et al merely discloses a tubular member 14, which is actually a flexible inner member, that assumes a configuration of multiple bends 50, 52 only when the bends are ejected from the outer rigid sheath. The tubular member 14 is in no way analogous to the angled outer tubular member recited in the claims of the subject application. The rejection of claims 1-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the Peters et al patent in view of the Aznoian et al patent is thusly submitted to be unjustified and should be withdrawn.

Claims 1-22 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 6-16 and 20-22 of U.S. Patent No. 6,533,749 to Mitusina et al in view of the Aznoian et al patent, and this rejection too is submitted to be improper. The Mitusina et al patent and the subject application do

not claim common subject matter. Independent claim 1 and dependent claims 2 and 6-13 of Mitusina et al claim a helical cut, without any pattern, formed in the inner tube whereas each independent claim 1, 9 and 14 in the subject application claims a helical cut formed in a stepped pattern. Independent claim 14 and its dependent claims 15, 16 and 20-22 of Mitusina et al recite the step of forming a helical cut in the inner tube, again without any stepped pattern, as well as the step of bending the outer member after the inner member has been inserted into the outer member. Mitusina et al does not claim the same subject matter as the subject application because it does not claim or disclose a helical cut formed in a stepped pattern and, furthermore, the step of bending required in claims 14-16 and 20-22 of Mitusina et al form no part of the invention claimed in the subject application. The issue of the stepped pattern for the helical cut not being an obvious design choice has already been discussed above. The disclosure by Aznoian et al of a flexible inner tubular member that assumes a multiple bend configuration when ejected from a rigid outer sheath does not provide any teachings combinable with those of Mitusina et al to render the claimed invention obvious. Accordingly, the rejection of claims 1-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 6-16 and 20-22 of the Mitusina et al patent in view of the Aznoian et al patent is believed to be unjustified and should be withdrawn.

The rejection of claims 1, 6, 7, 9-11 and 14-21 as being anticipated by the Peters et al publication (US 2002/0038129) is respectfully traversed. The Peters et al publication fails to disclose or suggest a helical cut formed in the inner tube in a stepped pattern. Rather, the helical cut disclosed in the Peters et al publication is

formed in the inner tube in a dovetail pattern to intentionally form interlocked tenons and mortises. The dovetail pattern and interlocked tenons and mortises disclosed by Peters et al are not analogous to the stepped pattern claimed for the helical cut in each of the independent claims 1, 9 and 14 of the subject application, it being noted in particular that the stepped pattern does not result in interlocked tenons and mortises. Moreover, the Peters et al publication does not recognize the limitation or requirement that there be no more than a single layer of spiral wrap disposed over the helical cut formed in the inner tube. The Peters et al publication discloses first and second spiral wrap layers disposed over the helical cut in the inner tube which demonstrates that Peters et al did not contemplate the object achieved with the claimed invention where the inner tube used to form the inner tubular member of the angled tissue cutting instrument is the same as the inner tube of a straight tissue cutting instrument of the same standard diametric size as the angled tissue cutting instrument. The Examiner attempts to make a correspondence between the dovetail pattern disclosed by Peters et al and the stepped pattern claimed in the claims of the subject application, but this correspondence can only be made using a strained interpretation of Peters et al with disregard for the actual features and intent of the disclosure and with disregard for the common accepted meanings for the terms "tenons" and "mortises". The only way it can be considered obvious to modify Peters et al to replace the dovetail pattern with a stepped pattern is with the use of impermissible hindsight made possible only from the teachings of the subject invention itself. In Peters et al, operation of the flexible inner tubular member to transmit torque relies on interlocking tenons and mortises whereas the claimed invention does not require the same type of structural interlocking

elements. Accordingly, it is submitted that claims 1, 6, 7, 9-11 and 14-21 cannot be anticipated by Peters et al and that claims 1, 6, 7, 9-11 and 14-21 are clearly patentable over Peters et al and should be allowed along with their dependent claims 2-5, 8, 12, 13 and 22.

Claims 2-5, which depend from independent claim 1, stand rejected as being unpatentable over the Peters et al publication as applied to claim 1 in view of the Aznoian et al patent. However, Aznoian et al fails to rectify any of the aforementioned deficiencies of Peters et al and, in addition, does not disclose or suggest an outer tubular member having the features recited in claims 2-5. As pointed out above, Aznoian et al discloses a flexible inner member 14 that assumes a configuration of multiple bends 50,52 only when the bends are ejected from an outer sheath. The inner member 14 of Aznoian et al is not analogous to the outer tubular member recited in claims 2-5 and does not provide any teachings or suggestions which would make it obvious to modify the outer member in the Peters et al publication to arrive at the features recited in claims 2-5. Dependent claims 2-5 are thusly submitted to be clearly patentable over the Peters et al publication in view of Aznoian et al for the additional features recited therein as well as being allowable with independent claim 1.

Dependent claims 8, 12, 13 and 22 stand rejected as being unpatentable over Peters et al as applied to claims 7, 9, 14 and 16. Claims 8, 12 and 22 recite a particular rotational interval for the steps forming the stepped pattern of the helical cut and, as pointed out above, Peters et al does not even disclose a stepped pattern but, on the contrary, a dovetail pattern forming interlocking tenons and mortises. Peters et al does not disclose any particular rotational interval for the tenons and mortises, much less for

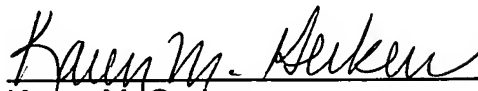
the steps recited in claims 8, 12 and 22. Dependent claim 13 recites features pertaining to the length of the longitudinal cut segment and the transverse cut segment of the steps which cannot be considered obvious from Peters et al in view of the failure of Peters et al to disclose steps as opposed to dovetails, i.e. interlocking tenons and mortises. Claims 8, 12, 13 and 22 are thusly submitted to be clearly patentable over Peters et al for the additional limitations recited therein as well as being allowable with their respective independent claims.

Dependent claims 17-19 stand rejected as being unpatentable over Peters et al as applied to claim 14 and in view of applicant's disclosure. A requirement of dependent claims 17-19 is that the inner tube used to form the inner tubular member of the angled tissue cutting instrument be the same as the inner tube of a straight tissue cutting instrument of the same standard diametric size as the angled tissue cutting instrument, and this feature is not disclosed or suggested by Peters et al nor is it obvious from Peters et al in view of applicant's disclosure. The only way the features recited in claims 17-19 can be considered obvious over Peters et al is to improperly use applicant's disclosure as a template or guide to reconstruct the invention of Peters et al beyond the reasonable metes and bounds of its disclosure. It is thusly maintained that dependent claims 17-19 are clearly patentable over Peters et al in view of applicant's disclosure for the additional features recited therein as well as being allowable with independent claim 14.

In light of the foregoing, all of the claims in the subject patent application are submitted to be in condition for allowance. Action in conformance therewith is courteously solicited. Should any issues in the subject application remain unresolved,

the Examiner is encouraged to contact the undersigned attorney.

Respectfully submitted,

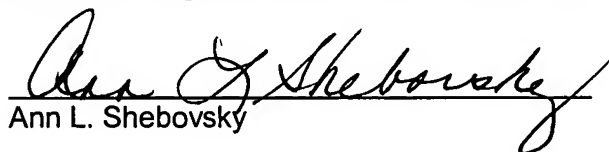
A handwritten signature in cursive script, reading "Karen M. Gerken", written over a horizontal line.

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 7, 2007.

A handwritten signature in cursive script, reading "Ann L. Shebovsky", written over a horizontal line.

Ann L. Shebovsky